

CERTIFICATE OF ELECTRONIC TRANSMISSION UNDER 37 C.F.R. §1.8

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Date March 28, 2008 Name Robert K. Fergan Signature /Robert K. Fergan/

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: John J. Connors, III, et al.

Appln. No.: 10/813,423

Examiner: Rosie Yuh Loo Chang

Filed: March 30, 2004

Art Unit: 1762

For: WIRE GUIDE

Attorney Docket No: 8627-452

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF UNDER 37 C.F.R. §41.41

Sir:

This Reply Brief is filed in response to the Examiner's Answer mailed on January 30, 2008. Because this Reply is submitted on or before March 30, 2008, this Reply is timely filed.

Based on a review of the examiner's answer, applicants believe a brief summary of the applicant's arguments will be helpful to highlight unsupported assumptions in the examiner's answer. The examiner's argument relies on two assumptions. First the examiner assumes that a hydrophilic coating is applied to the proximal section prior to the cleaning process although this is not disclosed in the *Engelson* reference. Second, the examiner assumes that if the hydrophilic coating is applied prior to cleaning, it would be inherently sprayed on the distal section of the wireguide.

The *Engelson* reference teaches two processes, the first process with reference to Figure 1 and the second process with reference to Figure 2. In the examiner's answer, the examiner combines elements from the first and second process. Applicants feel it is necessary to clarify these processes. The first process is described starting at Column 5, Line 8 and shown in Figure 1. The first process includes applying a fluorocarbon polymer coating 103 on the proximal section of the wireguide core, applying a tie layer 110 on the distal section of the wireguide core, and applying a polymer coating 108 over the tie layer. No cleaning process is discussed with regard to this process.

Separately, the second process is described starting at Column 10, Line 7 and is shown in Figure 2. The process describes that the *wireguide core* is etched and a layer of hydro-carbon residue is formed as a tie layer (Lines 15-20). Then additional coatings are added for example by dipping or other processes (Lines 48+).

The examiner contends that a hydrophilic coating like coating 103 is applied to the wireguide core prior to the etching described in Column 10. However, the

reference does not disclose that the proximal coating is applied prior to etching and indicates that only the wireguide core is etched.

Further, even if the proximal coating were applied prior to etching, the examiner contends that the coating would be inherently sprayed on the distal section. It is undisputed that the reference *does not* explicitly disclose the coating 103 being applied the distal section. To the contrary, the reference only indicates the coating 103 is applied to the proximal section adjacent to coatings 108 and 110 on the distal section. Rather, the examiner contends that the coating would be inherently sprayed on the distal section because the reference is *silent* about any masking.

Indeed, the reference is *silent*. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference. *In re Robertson*, 169 F.3d 743, 745; 49 U.S.P.Q. 2d 1949, 1950-51 (Fed. Cir. 1999). The omission of a discussion on masking does not make clear that overspray is necessarily present on the distal section. The reference does not discourage masking. The spray could also be controlled in other ways, such as controlling the spray angle to avoid inadvertent overspray. Regardless, applicants respectfully submit that "the mere fact that a certain thing may result from a given set of circumstances is not sufficient" and "[i]nherency may not be established by probabilities or possibilities." *Id.*

Under a finding of anticipation, the examiner bears the burden of establishing that each and every element of the claimed invention is taught by the reference. Applicants respectfully submit that the examiner has not met that burden. The

assumptions made by the examiner to reject the instant application are not supported by facts or affirmative teachings in the cited reference, but rather hindsight adaptations to fill in omissions of the reference. Accordingly, applicants respectfully request withdrawal of the rejections and allowance of the claims as currently presented.

Respectfully submitted,

Dated: March 28, 2008

/Robert K. Fergan/
Robert K. Fergan (51,674)